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09/880,039	06/14/2001	Takeo Katsuda	011350-276	5950

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EXAMINER

DUONG, THOMAS

ART UNIT	PAPER NUMBER
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2145

MAIL DATE	DELIVERY MODE
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03/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/880,039	Applicant(s) KATSUDA, TAKEO	
	Examiner THOMAS DUONG	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-31 and 37-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-30, 37, 39, 41, 43, and 47 is/are allowed.
- 6) ☒ Claim(s) 14, 31, 38, 40, and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the Applicant's Appeal Brief filed on July 23, 2007. *Claims 14-31 and 37-47* are presented for further consideration and examination.
2. In view of the Appeal Brief filed on July 23, 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

Response to Argument

3. Applicant's arguments, see pg.11-13, filed on July 23, 2007, with respect to *claims 15, 37, 39, 41, and 43* have been fully considered and are persuasive. The previous rejection is withdrawn. New grounds of rejection are set forth below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 14 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al. (US006421707B1).

6. With regard to claims 14 and 31, Miller discloses,

- *an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit; (Miller, col.1, lines 41-51, lines 54-58; col.3, lines 33-38; col.6, lines 25-40; col.9, lines 24-28; fig.7)*

Miller teaches of “[allowing] the selective retrieval and formatting of messages sent to a mobile subscriber” (Miller, col.6, lines 26-27). Miller discloses “the present invention permits a subscriber to a wireless communications service to receive and generate multimedia messages from known wireless personal communications devices, i.e., cellular telephones” (Miller, col.1, lines 44-46).

Hence, Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller and a receipt notification is selectively generated and delivered to the mobile subscriber.

- *an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail; (Miller, col.1, lines 52-55; col.3, lines 33-38; col.4, lines 40-43; col.9, lines 41-46)*

Miller discloses, “importantly, the output need not be a ‘message’ but could simply be notification that a message has been received” (Miller, col.3, lines 34-36). Hence, Miller teaches of an environment where a receipt notification is generated and delivered to the mobile subscriber in response to receiving a message. In addition, Miller’s environment allows the subscriber the ability to

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customize the message receipt notification through the use of a user-specific agent.

- *an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices; (Miller, col.1, lines 52-55; col.9, lines 41-46)*

Miller teaches of an environment where a receipt notification is generated and delivered to the addressee.

- *an instruction receiving device receiving an E-mail including an instruction for specifying one of multiple image output devices; (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)*

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] ... the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38).

- *a converting device converting the attachment file portion into data of a format acceptable to the image output device; and (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)*

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference. According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] ... the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38).

- *a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 38, 40, 42, and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US006421707B1) and in view of Theimer et al. (US005493692A).

9. With regard to claims 38, 40, 42, and 44-46, Miller discloses,

- *receiving E-mail addressed to a certain destination*; (Miller, col.1, lines 41-51, lines 54-58; col.3, lines 33-38; col.6, lines 25-40; col.9, lines 24-28; fig.7)

Miller teaches of “[*allowing*] the selective retrieval and formatting of messages sent to a mobile subscriber” (Miller, col.6, lines 26-27). Miller discloses “*the present invention permits a subscriber to a wireless communications service to receive and generate multimedia messages from known wireless personal communications devices, i.e., cellular telephones*” (Miller, col.1, lines 44-46).

Hence, Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller and a receipt notification is selectively generated and delivered to the mobile subscriber.

- *preparing receipt notice E-mail based on the received E-mail*; (Miller, col.1, lines 52-55; col.3, lines 33-38; col.4, lines 40-43; col.9, lines 41-46)

Miller discloses, “*importantly, the output need not be a ‘message’ but could simply be notification that a message has been received*” (Miller, col.3, lines 34-36). Hence, Miller teaches of an environment where a receipt notification is generated and delivered to the mobile subscriber in response to receiving a message. In addition, Miller’s environment allows the subscriber the ability to customize the message receipt notification through the use of a user-specific agent.

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- *transmitting said receipt notice E-mail to said destination; (Miller, col.1, lines 52-55; col.9, lines 41-46)*

Miller teaches of an environment where a receipt notification is generated and delivered to the addressee.

- *selecting one of multiple image output devices on the basis of the location information of said destination acquired; (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)*

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] ... the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38).

- *sending an E-mail to said destination containing a notification of the selected image output device; and (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)*

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber

or outputted to a device (i.e., facsimile) according to subscriber's preference.

According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] ... the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38).

- *transmitting at least a portion of the data of the received E-mail to the selected image output device.* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

However, Miller does not explicitly disclose,

- *acquiring location information of said destination;*

Theimer teaches,

- *acquiring location information of said destination;* (Theimer, col.8, lines 40-58; col.9, lines 7-20; col.24, lines 8-48; fig.16)

Theimer teaches of an environment where a message is received at a portable terminal unit, the available delivery methods based on the location of the subscriber are detected, and delivering the data to the appropriate output or display device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Theimer with the teachings of Miller to selectively deliver messages to a subscriber of the wireless service base on the available as well as appropriate output or display methods in proximity to the subscriber. According to Theimer, it is advantageous to *“provide a system in which the delivery of electronic messages to a particular user or users may be selective, depending upon the context or state of the user or users. Furthermore, appropriate computing devices for particular actions, such as delivery of electronics messages, are selected based on the environment in proximity to the user in relation to the properties of the message”* (Theimer, col.4, lines 5-12).

Response to Arguments

10. Applicant's arguments with respect to *claims 14, 31, 38, 40, 43, and 44-46* have been considered but they are not persuasive.

Allowable Subject Matter

11. *Claims 15-30, 37, 39, 41, and 43* are allowed. The claims indicated include limitations that the prior arts of record do not appear to teach or render obvious, hence they are allowed.
12. The following is an examiner's statement of reasons for allowance:

As presented in the previous Office Action, Miller et al. (US006421707B1) teaches of step of locating the mobile subscriber *“according to the rules he [has] previously established (or defaulted to, as appropriate)”* (Miller, col.5, lines 2-3). According to

Miller, *"the ability for a user (recipient) to define a set of rules that determine how/when messages and their notification are to be treated ... such as a permanent rule (SMS notification to Thomas' handset) and a vacation rule (e.g., hold messages but notify Thomas at his hotel telephone), ... etc., are easily envisioned and implemented as appropriate"* (Miller, col.4, lines 49-60). In addition to the established rules, the fact that the message was delivered to the user via the wireless device is evidence that the user was located. When the user receives the message notifying of the impending e-mail and attachments, the user can choose the appropriate outputting device. In another embodiment, Miller allows for the automatic delivery of the attachment to the user based on the user's profile. Hence, Miller describes a method of locating the subscriber via established rules, in addition to the actual wireless device, and determining the appropriate outputting device to which the notification message is directed. Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference. Furthermore, Miller teaches of step of locating the mobile subscriber *"according to the rules he [has] previously established (or defaulted to, as appropriate)"* (Miller, col.5, lines 2-3). According to Miller, *"the ability for a user (recipient) to define a set of rules that determine how/when messages and their notification are to be treated ... such as a permanent rule (SMS notification to Thomas' handset) and a vacation rule (e.g., hold messages but notify Thomas at his hotel telephone), ... etc., are easily envisioned and implemented as appropriate"* (Miller, col.4, lines 49-60). Hence, Miller describes a method of locating the subscriber via established

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rules and determining the appropriate outputting device to which the notification message is directed.

Also presented in the previous Office Action, Theimer et al. (US005493692) teaches of an environment where a message is received at a portable terminal unit, the available delivery methods based on the location of the subscriber are detected, and delivering the data to the appropriate output or display device.

However, the prior arts of record fail to teach or suggest individually or in combination as stated in the independent claims for *“a location information acquiring device acquiring location information of said portable terminal unit; a selecting device selecting one of multiple image output devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device; a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device; and a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device”* and in combination with other limitations as set forth in the independent claims, as well as Applicant's arguments presented on pages 11-13 of the Appeal Brief filed on July 23, 2007. In the fore mentioned amendment, the Applicant argued, *“After carefully considering the Examiner's arguments on pages 24-28 of the final Office Action, the characterization of the Miller system, the language quoted from Column 3 of the Miller patent, and the other cited columns and lines, the Appellant was unable to find the claimed feature of a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device in the Miller patent”* (pg.11).

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 571/272-3911. The examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason D. Cardone can be reached on 571/272-3933. The fax phone numbers for the organization where this application or proceeding is assigned are 571/273-8300 for regular communications and 571/273-8300 for After Final communications.

Thomas Duong (AU2145)

March 28, 2008

*/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145*